

Remarks:

4. Claims 1-3 and 4 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1, 3, 2 and 6 of co-pending application no. 10/762,103. Applicants respectfully disagree. The following table contains the identified claims from the present application (10/762,104) to those of co-pending application no. 10/762,103. It is clear from the side-by-side comparison that claims 1-4 of the present application recite a laminate that is patentably distinct from the laminate recited within claims 1-3 and 6 of co-pending application no. 10/762,103; e.g., claim 1 of the present application recites a laminate that comprises: a substrate and a backer layer, neither of which are claimed in the '103 application. Other differences exist as well.

U.S. Pat. Appl. S/N 10/762, 104	U.S. Pat. Appl. S/N 10/762, 103
1. A heat and pressure consolidated laminate, comprising in superimposed relationship: a decorative layer consisting essentially of a leather material; a substrate, having a first surface and a second surface opposite one another; an underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin, the underlay layer disposed between the decorative layer and the first surface of the substrate; and a backer layer containing one or more cellulosic sheets impregnated with a thermosetting resin, the backer layer disposed adjacent the second surface of the substrate.	1. A heat and pressure consolidated laminate, comprising in superimposed relationship: a core layer containing at least one cellulosic sheet impregnated with a thermosetting resin; and a first decorative layer consisting essentially of a leather material.
2. The laminate of claim 1 wherein said decorative layer is bonded leather having a sheet thickness ranging from about 0.2 mm to about 4.0 mm.	2. The laminate of claim 1 wherein said thermosetting resin is a phenol-formaldehyde resin.
3. The laminate of claim 1 wherein said thermosetting resin is a melamine formaldehyde resin.	3. The laminate of claim 1, wherein said decorative layer is bonded leather having a sheet thickness ranging from about 0.2 mm to about 4.0 mm.
4. The laminate of claim 1, wherein said substrate is either plywood, particleboard or medium density fiberboard.	6. The laminate of claim 1, further comprising a backer layer of at least one cellulosic sheet impregnated with a thermosetting resin, said backer layer being disposed on the side of the core layer opposite the decorative layer.

Consequently, applicants respectfully request this rejection be withdrawn.

4. Claims 1, 4 and 5 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 2,622,991 (hereinafter the “ ‘991 Patent”). Applicants respectfully disagree.

The classic test for anticipation, under 35 U.S.C. §102(b), requires that every limitation in a claim must be present in a single source reference for that reference to "anticipate" the claimed invention. Independent claim 1 recites: 1) a decorative layer consisting essentially of a leather material; 2) a substrate having a first surface and a second surface opposite one another; 3) an underlay layer, containing one or more cellulosic sheets impregnated with a thermosetting resin, which underlay layer is disposed between the decorative layer and the substrate; and 4) a backer layer containing one or more cellulosic sheets impregnated with a thermosetting resin, wherein the backer layer is disposed adjacent the second surface of the substrate. To be anticipated, therefore, the ‘991 Patent must disclose the recited structure. It does not.

The ‘991 patent discloses a process for printing on *thermoplastics*; i.e., a disclosure directed toward solving the problem of “applying paint or similar coating layers to *thermoplastic materials*”. (Col. 1, lines 14-16; emphasis added) The invention, according to the ‘991 patent, is a process for printing on thermoplastics, and in particular thermoplastic materials of the acrylic type that may be superimposed or interposed with a layer(s) of material “which may itself be printed, coloured, or coated, and which may be of non-plastic character; examples of the material which may be used are paper, textiles, leather...”. (Col. 1, lines 7-13 and 27-36). (Col. 1, lines 7-13)

The thermoplastic materials disclosed within the ‘991 patent are not the same as or equivalent to the thermosetting resin recited within claim 1. Applicants provide definitions of “thermosetting plastics” and “thermoplastic” herewith that clearly illustrate the difference between the two materials. In fact, there is no disclosure or suggestion within the ‘991 Patent of an under layer or a backer layer containing a cellulosic sheet impregnated with a thermosetting resin. For at least these reasons, applicants respectfully request the rejection of claims 1, 4 and 5 be withdrawn.

6. Claims 2 and 3 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '991 Patent as applied to claims 1, 4 and 5 above, and further in view of U.S. Patent No. 4,255,480 (hereinafter referred to as the '480 Patent). Applicants respectfully disagree.

Claims 2 and 3 depend from claim 1. For the reasons set forth above relating to Claim 1, applicants respectfully request this rejection be withdrawn.

To arrive at the claimed laminate, the Examiner indicates that the '480 Patent teaches core sheets impregnated with a formaldehyde resin used within a laminate as taught by the '991 Patent, and cites Col. 1, lines 50-80 (assumably of the '480 Patent) as support. Applicants traverse the Examiner's statement and respectfully submit that there is no such disclosure within the '480 Patent, and in particular no such disclosure in Col. 1, lines 50-80.

The Examiner indicates further that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the references "to impart desired characteristics/properties to the product in the absence of unexpected results". Applicants respectfully traverse.

When an application is submitted to the Patent and Trademark Office, statute<sup>1</sup> and case law<sup>2</sup> dictates that the burden of proof is on the PTO to establish a prima facie case of obviousness.<sup>3</sup> Once the prima facie case has been established, then the burden of going forward with the evidence to rebut the prima facie case shifts to the applicant.<sup>4</sup> Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden of persuasion remains with the PTO.<sup>5</sup> In this instance, a prima facie case would necessarily

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<sup>1</sup> 35 U.S.C. 132.

<sup>2</sup> See In re Warner, 154 USPQ 173, 178 (C.C.P.A. 1967); In re Oetiker, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992).

<sup>3</sup> In re Piasecki, 223 USPQ 785, 788 (Fed. Cir. 1984).

<sup>4</sup> In re Carleton, 202 U.S.P.Q. 165, 168 (CCPA 1979).

<sup>5</sup> Ashland Oil v. Delta Resins and Refractories, Inc., 227 U.S.P.Q. 657, 659 (Cir. Fed. 1985). See also In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Cir. Fed. 1992): "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. '[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' The patent applicant may then attack the Examiner's prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness.",.

have to first establish that the combined teachings of the '991 and '480 patents render the claimed subject matter obvious<sup>6</sup>, and second provide a suggestion or motivation within the cited references to combine the cited references to arrive at the claimed invention.<sup>7</sup> The suggestion or motivation to combine the references must not be a hindsight reconstruction of isolated disclosures within the prior art.<sup>8</sup> Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.<sup>9</sup>

As stated above, the references do not disclose the elements recited within claims 1, 2 or 3 and the recited structure. Consequently, the combination of the cited references does not arrive at the claimed invention.

In addition, however, there is no suggestion or motivation to combine the references as suggested by the Examiner. The fact that the '480 Patent discloses the use of a formaldehyde resin does not provide a suggestion or motivation to combine the references to arrive at the claimed laminate. The '991 patent discloses a process for printing on thermoplastics. In some embodiments, an ink or other printing material is applied to an acrylic sheet. In other embodiments, a layer of material 13 (e.g., paper) is disposed between thermoplastic layers (e.g., see FIG. 4). The '480 patent, on the other hand, discloses an abrasion resistant laminate that includes a core sheet layer combined with a pattern sheet. One of the objects of the '480 Patent is provide a high-pressure decorative laminate that does not contain an overlay sheet. (Col.5, lines 39-41) Consequently, the '480 patent teaches away from the combination suggested by the Examiner. The suggested combination to arrive at the claimed laminate is therefore without merit, and appears to be the product of impermissible hindsight.

In addition to the above, claim 2 recites a decorative layer comprising bonded leather. There is no disclosure in either reference regarding the use of bonded leather.

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<sup>6</sup> In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979) citing In re Bozek, 163 USPQ 545, 549-550 (C.C.P.A. 1969).

<sup>7</sup> ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984), "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can only be combined if there is some suggestion to do so."

<sup>8</sup> In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992), "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention", quoting In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

<sup>9</sup> In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

Applicants respectfully direct the Examiner to pages 1 and 2 of the present application wherein the disadvantages of natural leather (e.g., shrinkage, defects, size limitations, etc.) and the advantages of bonded leather (e.g., negligible shrinkage, pre-prepared product, no stretching required, virtually no size limitations, etc.) are described. As the present application describes, the differences between natural and bonded leather are significant for the uses described. For at least these reasons, applicants respectfully submit that the subject matter recited in claim 2 is not obvious in view of the cited references.

As applicant has traversed the rejection made by the Examiner, it is respectfully requested that the stated rejections be withdrawn, claims 1-20 be allowed, and the present application be passed onto issuance. No fee is believed due with the present application. In the event a fee is due, please charge our Deposit Account No. 50-3381.

Respectfully submitted,



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